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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,046	10/22/2003	Richard S. Valpey III	J-3456A	2051

7590

11/09/2006

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EXAMINER

MRUK, BRIAN P

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,046

Applicant(s)

VALPEY ET AL.

Examiner

Brian P. Mruk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) 3-9, 26 and 29-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10-21, 23-25, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. This Office action is in response to Applicant's amendment filed September 5, 2006. Applicant has amended claim 1. Claim 22 has been cancelled. Claims 3-9, 26 and 29-36 are withdrawn from consideration. Currently, claims 1-21 and 23-36 remain pending in the application.
2. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office action, Paper No. 20060530.
3. The rejection of claims 1-2, 10-12, 15-21, 23-25 and 28 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cavanagh et al, U.S. Patent No. 5,256,328, is maintained for the reasons of record.
4. The rejection of claims 1-2, 10-21, 23-25 and 27-28 under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rohrbaugh et al, WO 01/96511, is maintained for the reasons of record.

Response to Arguments

5. Applicant's arguments filed September 5, 2006 have been fully considered but they are not persuasive.

Applicant argues that Cavanagh et al, U.S. Patent No. 5,256,328, includes 35-75% by weight of nanoparticles and 0.2-10% by weight of surfactants, which would make it difficult to form a transparent coating as recited in newly amended claim 1. However, the examiner respectfully disagrees. Specifically, the recitation of "a self-cleaning transparent coating is formed on a surface" is an intended use limitation, and thus, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant further argues that their 1.132 Declaration has shown that the compositions of Cavanagh et al would not form a transparent coating. However, the examiner asserts that applicant's 1.132 Declaration cannot overcome the 102 rejections in the instant application. Furthermore, with respect to the 103 rejections, the examiner asserts that applicant's 1.132 Declaration is not commensurate in scope with the claimed invention, as required by MPEP 716.02(d). Specifically, independent claim 1 does not require specific weight percentages of nanoparticles or surfactants, and therefore, the examiner asserts that independent claim 1, as presently written, is open to any amount of these components. Therefore, the examiner asserts that applicant's 1.132 Declaration cannot overcome the 103 rejections of the instant claims over Cavanagh et al, since the showing is not commensurate in scope with the claimed invention. Furthermore, the examiner asserts that applicant's opinion that the compositions of Cavanagh would not form transparent coatings is not sufficient

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evidence to overcome the rejection of record. See MPEP 716. Therefore, the examiner asserts that applicant has not met the burden for establishing that the compositions of Cavanagh et al do not form transparent coatings.

Applicant argues that Rohrbaugh et al, WO 01/96511, does not meet the newly added limitation of having a surface energy below 30 dynes per centimeter, as recited in instant claim 1. However, the examiner respectfully disagrees. Specifically, the examiner asserted in the last Office action that the coating compositions disclosed in Rohrbaugh et al would inherently meet the surface energy requirements of the instant invention, since the coating compositions disclosed in Rohrbaugh et al contain all of the required components in the amounts required in the instant claims, absent a showing otherwise. Furthermore, applicant has not met the burden of proof that the compositions of Rohrbaugh et al do not have a surface energy below 30 dynes per centimeter. See MPEP 2112.01. Specifically, applicant's opinion that the compositions of Rohrbaugh et al would not have a surface energy below 72 dynes per centimeter does not constitute a proper showing. See MPEP 716.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Mon-Thurs (7:00AM-5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BPM

Brian P. Mruk
November 7, 2006

Brian P. Mruk

Brian P Mruk
Primary Examiner
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